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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/042,854	01/09/2002	William A. Hartselle	60027.0093US01	6891
39262 7590 08/30/2007 MERCHANT & GOULD BELLSOUTH CORPORATION P.O. BOX 2903 MINNEAPOLIS, MN 55402			EXAMINER TANG, KAREN C	
			ART UNIT 2151	PAPER NUMBER
			MAIL DATE 08/30/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/042,854

Applicant(s)

HARTSELLE ET AL.

Examiner

Karen C. Tang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 8-15, 19-29, 31 and 32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 8-15, 19-29, 31 and 32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

- This action is responsive to the amendment and remarks file on 7/12/07.
- Claims 1-5, 8-15, 19-29, 31 and 32 are presented for further examination.

DETAILED ACTION

Response to Arguments

Applicant's arguments with respect to claims 1-5, 8-15, 19-29, 31 and 32 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-5, 8-15, 19-29, 31, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ogilvie (US 6,711,608) in view of Nakada et al hereinafter Nakada (US 6,654,786) in further view of Nakada et al hereinafter Nakada960 (US 2001/0030960) and Meister et al hereinafter Meister (US 2004/0103162).

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1. Referring to Claims 1, 8 and 19, Ogilvie discloses a system for providing self-destructing electronic mail messages (refer to Abstract), the system comprising: an electronic mail server application operative to receive a request to transmit a self-destructing electronic mail message (refer to Col 9, Lines 5-20), to transmit the self-destructing electronic mail message to an electronic mail client application (218 and 202, refer to Fig 2), and to cause all instances of the self-destructing electronic mail message to be destroyed after a period of time specified in the request (refer to Col 11, Lines 40-50) and electronic mail client application operative to transmit the request to the electronic mail server application (refer to Col 9, Lines 5-35), the request comprising an electronic mail message body and specifying a period of time within which the self-destructing electronic mail should be destroyed (refer to Col 11, Lines 40-50), wherein the all instances of the self-destructing electronic mail message comprises a plurality of electronic copies of the self-destructing electronic mail message stored in at least one of the following: computer system memory and a mass storage device (refer to Col 4, Lines 20-50, Col 9, Lines 20-60, and Col 11, Lines 1-15).

determining if an intended receipt's electronic mail server application supports receiving self-destructing electronic mail messages (transmission protocol, which insure the receiving side supports the self-destructing electronic mail messages, refer to Col 7, Lines 10-25 and Col 10, Lines 35-50);

if the intended recipient's electronic mail server application does not support self destructing electronic mail messages (sent to the unintended location, refer to Col 10, Lines 3);

provide a security warning message ("remove from mail list", refer to Col 9, Lines 5-20) prior to transmitting the request in response to determining that an intended recipient of the self-

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destructing electronic mail message is located beyond a home domain associated with the electronic mail server application (it is inherent that once the client has provide a message, the message itself will return the message to the server of originator 200, that ensure the domain is associated with the server and Col 10, Lines 35-50),

Ogilvie did not expressly indicate “notifying a sender that the intended recipients mail server does not support self-destructing electronic mail messages”;

Nakada discloses a system that “provides an notification that back to the sender when the mail wasn’t deliver successfully” (refer to Col 6, Lines 25-40, and Col 9, Lines 45-60, and Col 10, Lines 29-40).

The suggestion/motivation would have been that in Nakada system, it indicates if the deliver wasn’t successfully, the system it will urge the sender to verify the sending address to ensure the successful transmission to the intended party.

Although both Ogilvie and Nakada disclose the invention substantially as claimed, both Ogilvie and Nakada are silent regarding “determining if an electronic mail address is located on a network beyond the sender’s home domain”; and “canceling the electronic mail message to the intended recipient whose electronic mail address is located on the network beyond the sender’s home domain”;

Nakada960, in an analogous art discloses, “determining if the electronic mail address is located on a network beyond the sender’s home domain” (refer to 0125);

“canceling the electronic mail message to the intended recipient whose electronic mail address is located on the network beyond the sender’s home domain” (refer to 0125);

Hence, providing the determine own domain ability disclosed by Nakada, would be desired for user to implement in their system to filter certain unwanted messages that contains undesired domain.

Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the system of Ogilvie by including the features, which exclude unwanted domain message.

Although Ogilvie, Nakada, and Nakada960 disclosed the invention substantially as claimed, Ogilvie, Nakada, and Nakada960 are silent regarding “receiving a response to the security-warning message either transmitting or canceling the mail messages”.

Meister, in an analogous art discloses “the system receiving a response to the security-warning message either transmitting or canceling the mail messages” (refer to 0036).

Hence, providing features disclosed by Meister, would be desired for a user to implement in the system in order to allow the user to edit the message considering the address might be a mistake. Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the system of Ogilvie, Nakada, and Nakada960 by including the features presented by Meister.

2. Referring to Claim 2, Ogilvie discloses wherein the time period comprises an indication that the self-destructing electronic mail message (refer to Abstract) should be destroyed after it has been opened and closed on the electronic mail client application (refer to Col 11, Lines 40-50 and Col 6, Lines 1-20).

3. Referring to Claims 3 and 28, Olgilvie discloses further comprising; transmitting an electronic mail message to the electronic mail client application (218 and 202, refer to Fig 2) indicating that the self-destructing electronic mail message has been destroyed after the destruction of the self-destructing electronic mail message (refer to Col 9, Lines 40-67).

4. Referring to Claim 4, Olgilvie discloses wherein the electronic mail message sent to the electronic mail client application (218 and 202, refer to Fig 2) after the destruction of the self-destructing electronic mail message comprises an identity of the sender of the self-destructing electronic mail message (refer to Col 7, Lines 1-10) and an indication that the self-destructing electronic mail message was sent and destroyed (refer to Col 9, Lines 60-67 and Fig 2).

5. Referring to Claim 5, Olgilvie discloses encrypting the self-destructing electronic mail message prior to transmitting the self-destructing electronic mail message to the electronic mail client application (refer to Col 7, Lines 10-25, and Col 10, Lines 20-35 and Col 9, Lines 5-20).

6. Referring to Claims 9 and 20, Olgilvie discloses receiving a self-destructing electronic mail message sent from the electronic mail server application (218 and 202, refer to Fig 2); and destroying all instances of the electronic mail message (refer to Abstract) sent from the electronic mail server after a period of time specified in the self-destructing electronic mail message has elapsed (refer to Col 11, Lines 40-50).

7. Referring to Claims 10 and 21, Ogilvie discloses wherein the electronic mail client application is further operative to prevent the self-destructing electronic mail message from being printed (refer to Col 10, Lines 64-67 and Col 11, Lines 1-15).

8. Referring to Claims 11 and 22, Ogilvie discloses wherein the electronic mail client application is operative to prevent the self-destructing electronic mail message from being forwarded (refer to Col 7, Lines 25-45).

9. Referring to Claims 12 and 23, Ogilvie discloses wherein the electronic mail client application is further operative to prevent the self-destructing electronic mail message from being saved (refer to Col 7, Lines 25-45).

10. Referring to Claims 13 and 24, Ogilvie discloses wherein the electronic mail client application is further operative to prevent the self-destructing electronic mail message from being moved (forwarding, refer to Col 7, Lines 25-40).

11. Referring to Claims 14 and 25, Ogilvie discloses wherein the electronic mail client application is further operative to prevent the self-destructing electronic mail message from being copied or cut to a clipboard (refer to Col 11, Lines 10-20).

12. Referring to Claims 15 and 26, Ogilvie discloses wherein the electronic mail client application is further operative to prevent a screen display containing the self-destructing

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electronic mail message from being captured (refer to Col 11, Lines 50-67 and Col 12, Lines 1-10).

13. Referring to Claim 27, Ogilvie discloses wherein the period of time within which the self-destructing electronic mail message should be destroyed comprises an indication that the self-destructing electronic mail message should be destroyed immediately after it has been read on the electronic mail client application (refer to Col 3, Lines 30-35 and Col 6, Lines 5-20).

14. Referring to Claim 29, Ogilvie discloses wherein the electronic mail server application is further operative to encrypt the self-destructing electronic mail message and wherein the electronic mail client application is operative to decrypt the self-destructing electronic mail message (refer to Col 7, Lines 10-25, and Col 10, Lines 20-35).

16. Referring to Claim 31, Ogilvie did not disclose "removing an email address for the intended recipient whose electronic mail server application does not support self-destructing electronic mail messages".

Official notice is given that it is obvious of ordinary skill in the art to remove the recipient whose application does not support self-destructing electronic mail messages.

The suggestion/motivation would have been that by receiving the notification that delivery wasn't successful, to save the memory and to not resent to the same recipient again, it is necessary to delete the address.

17. Referring to Claim 32, Ogilvie discloses wherein notifying the sender comprises providing a user interface window and giving the sender an option to proceed with sending the self-destructing electronic mail message or canceling the self-destructing electronic mail message (refer to Col 9, Lines 1-10, the sender provides the ability to edit the self-removing email, also refer to Col 6, Lines 45-53).

Conclusion

Examiner's Notes: Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner. In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**


MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karen C. Tang whose telephone number is (571)272-3116. The examiner can normally be reached on M-F 7 - 3.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin-Wallace can be reached on (571)272-3440. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KT


VALENCIA MARTIN-WALLACE
PRIMARY EXAMINER